



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2016-0024]

Changes in Accelerated Examination Practice

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: In 2006, the United States Patent and Trademark Office (USPTO or Office) introduced the accelerated examination program to permit an application to be advanced out of turn if the applicant files a grantable petition under the program. Since its institution, the patent landscape has witnessed numerous legal changes such as the America Invents Act (AIA), the Patent Law Treaties Implementation Act (PLTIA) implementing the provisions of the Patent Law Treaty (PLT), and the USPTO's adoption of the Cooperative Patent Classification system (CPC) along with changes to USPTO systems. Accordingly, the Office is updating the accelerated examination program to reflect these changes in the law and examination practice.

DATES: Effective on [Insert publication date in the Federal Register]

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SUPPLEMENTARY INFORMATION:

I. Purpose of the Notice:

The USPTO published a notice in June 2006 (2006 AE Notice) to implement the accelerated examination program under which an application will be advanced out of turn for examination if the applicant files a petition to make special with the appropriate showing. See [Changes in Practice for Petitions in Patent Applications To Make Special and for Accelerated Examination](#), 71 FR 36323 (June 26, 2006). This showing requires the applicant to meet several conditions, including conducting a pre-examination search, providing an accelerated examination support document (AESD), and requiring the application be complete under 37 CFR 1.51 at the time of filing. In light of recent changes in the law such as the America Invents Act (AIA), Patent Law Treaties Implementation Act (PLTIA) to implement the provisions of the Patent Law Treaty (PLT) and the conversion to the Cooperative Patent Classification system (CPC), some of the requirements and practices of the program reflected in the 2006 AE Notice are no longer appropriate. Therefore, the program is being updated to account for these changes. The full updated accelerated examination guidelines may be found on the accelerated examination Web page (<http://www.uspto.gov/patent/initiatives/accelerated-examination>) and in a forthcoming update to the Manual of Patent Examining Procedure (MPEP). In particular, the changes are explained beginning at Section I.A of this notice. Subsequent to the implementation of the AE program in 2006, the Office implemented the prioritized examination program (referred to as “Track I”) provided for in the AIA in a final rule published on September 23, 2011. See [Changes to Implement the Prioritized Examination Track \(Track I\) of the Enhanced Examination Timing Control Procedures under the Leahy-Smith America Invents Act](#), 76 FR 59050 (September 23, 2011). Since implementation of Track I in 2011, the USPTO has received fewer than 200 AE requests

annually. In view of the relatively low usage of the AE program, the USPTO plans to publish a request for comments in the Federal Register to seek public input on whether there is value in retaining the AE program in view of the more popular Track I program.

A. Pre-examination Search

The 2006 AE Notice requires that the pre-examination search include a classification search of the United States Patent Classification system (USPC) by class and subclass. 71 FR at 36324. However, the USPTO has since harmonized its classification system for utility applications with Europe to create a common classification scheme known as the CPC. Therefore, a classified search of U.S. patents and published patent applications would need to include the relevant group(s)/subgroup(s) of the CPC rather than the class(es)/subclass(es) of the USPC. Applicants should consult with the USPTO's classification resources to determine the relevant group(s)/subgroup(s) of the CPC to consider. The classification resources may be found in Chapter 900 of the MPEP (<http://www.uspto.gov/web/offices/pac/mpep/documents/0900.htm>) and the Office of Patent Classification Home Page (<http://www.uspto.gov/patents-application-process/patent-search/classification-standards-and-development>). It is noted that a pre-examination search regarding a design application should continue to use the USPC because the CPC only applies to utility applications.

B. Accelerated Examination Support Document

The accelerated examination support document (AESD) was previously required to contain an indication of whether any cited references may be disqualified as prior art under pre-AIA 35 U.S.C. 103(c) as amended by the Cooperative Research and Technology Enhancement (CREATE) Act (Pub. L. 108-453, 118 Stat. 3596 (2004)). 71

FR at 36325. In 2011, the AIA was enacted, which amended 35 U.S.C. 103 to remove subsection (c). Instead, applicants enjoy a common ownership and obligation of assignment exception to prior art under AIA 35 U.S.C. 102(b)(2)(C). Therefore, an application that is subject to examination under AIA 35 U.S.C. 102 and 103 would need to, instead, include an indication in the AESD whether any of the cited prior art may be disqualified as prior art under 35 U.S.C. 102(b)(2)(C). Applications that are subject to examination under pre-AIA 35 U.S.C. 102 and 103 would need to continue to indicate whether any of the cited references are disqualified as prior art under pre-AIA 35 U.S.C. 103(c). Applicants should consult MPEP 2159 in ascertaining whether the application is subject to examination under pre-AIA or AIA 35 U.S.C. 102 and 103. Applicants are reminded, that if the application is filed on or after March 16, 2013, and claims the benefit of or priority to an application where the filing date of a foreign, U.S. provisional, U.S. nonprovisional, or international application is prior to March 16, 2013, it is necessary for the applicant to specify whether pre-AIA or AIA 35 U.S.C. 102 and 103 applies.

It is noted that further minor changes have been made to the 2006 AE Notice to reflect changes made by the AIA such as the citation change of 35 U.S.C. 112(a) and (f) and the appeal board's designation as the Patent Trial and Appeal Board (PTAB).

C. Reply by Applicant

The 2006 AE Notice provides shortened statutory periods of one month or thirty days, whichever is longer, without extensions under 37 CFR 1.136(a). 71 FR at 36325, 36327. This provision of the 2006 AE Notice was updated in 2013, when the Office issued a final rule to implement the PLT stating: "The Office is revising the Accelerated

Examination program to provide that Office actions (other than a notice of allowance) will set a shortened statutory period for reply of at least two months. In addition, extensions of this shortened statutory period under 37 CFR 1.136(a) will be permitted, but filing a petition for an extension of time will result in the application being taken out of the Accelerated Examination program.” Changes To Implement the Patent Law Treaty, 78 FR 62368, 62373 (Oct. 21, 2013).

D. Complete Application Upon Filing

In listing the conditions that must be met at the time of filing, the 2006 AE Notice states that no petition under 37 CFR 1.47 for a non-signing inventor may be present. 71 FR at 36327. However, in implementing the AIA, 37 CFR 1.47 was removed and 37 CFR 1.46 was amended to allow an assignee, an obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter to make an application for patent. Included among the amendments to 37 CFR 1.46 is a provision in 37 CFR 1.46(b)(2) that requires a petition in order to designate a person with sufficient proprietary interest as the applicant. Thus, the conditions for participation in the AE are hereby revised to preclude any petition under 37 CFR 1.46(b)(2) to designate a person with sufficient proprietary interest as the applicant. In fact, applicant should refrain from filing any petition that would delay the processing of the application including a petition under 37 CFR 1.78 to accept a delayed benefit claim.

Additionally, the 2006 AE Notice states that a foreign priority claim under 35 U.S.C. 119(a)-(d) should be identified in the executed oath or declaration or an application data sheet (if applicable). 71 FR at 36326. Further, the 2006 AE notice also states that any domestic benefit claim must be in the first sentence of the specification or in an

application data sheet. 71 FR at 36326. However, after the AIA, current rules require all domestic benefit and foreign priority claims to be made in the application data sheet (except for foreign priority claim in a national stage application under 35 U.S.C. 371) (see 37 CFR 1.55 and 1.78). Therefore, any priority claim would need to be made in an application data sheet under 37 CFR 1.76.

Finally, the 2006 AE Notice requires the applicant to file using the USPTO's electronic filing system (EFS) or EFS-Web. The USPTO's original electronic filing system (EFS) was discontinued. Therefore, applicants will need to file their accelerated examination applications through EFS-Web.

It is noted that an executed oath or declaration is no longer a condition for examination after the AIA. However, it is a requirement under 37 CFR 1.51 and will need to be present upon filing for entry in the program. A missing oath or declaration will not result in a notice to file missing parts when the application is reviewed by the Office of Patent Application Processing (OPAP). Nonetheless, the presence of the oath or declaration in compliance with 37 CFR 1.63 or substitute statement in compliance with 37 CFR 1.64 will subsequently be reviewed in the Technology Centers by the Quality Assurance Specialist (QAS) office. Failure to have a compliant oath, declaration, or substitute statement upon filing will prevent the application from being accorded special status.

II. Changes to the 2006 AE Notice:

As detailed above, the 2006 AE Notice has been modified to reflect changes in law and examination practice. The changes are set out below as paragraphs that replace paragraphs in the original notice.

The changes in Part I are as follows:

71 FR at 36324, col. 2, fifth paragraph (“(3)...”) is replaced with the following:

(3) The application, petition, and required fees must be filed electronically using the USPTO’s electronic filing system (EFS-Web). If the USPTO’s EFS-Web is not available to the public during the normal business hours for the system at the time of filing the application, applicant may file the application, other papers, and fees by mail accompanied by a statement that EFS-Web was not available during the normal business hours, but the final disposition of the application may occur later than twelve months from the filing of the application. See Part VIII (subsection The Twelve-Month Goal) for more information.

71 FR at 36324, col. 3, fourth paragraph (“(8)...”) is replaced with the following:

(8) At the time of filing, applicant must provide a statement that a preexamination search was conducted, including an identification of the field of search (i.e., group/subgroup of the CPC for utility applications and class/subclass of the USPC for design applications) and the date of the search, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file or files searched and the database service, and the date of the search.

71 FR at 36325, col. 1-2, ninth paragraph (“(E)...”) is replaced with the following:

(E) The accelerated examination support document must include a showing of where each limitation of the claims finds support under 35 U.S.C. 112(a) in the written description of the specification. If applicable, the showing must also identify: (1) Each

means- (or step-) plus-function claim element that invokes consideration under 35 U.S.C. 112(f); and (2) the structure, material, or acts in the specification that correspond to each means- (or step-) plus-function claim element that invokes consideration under 35 U.S.C. 112(f). If the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 U.S.C. 112(a) in each such application in which such support exists.

71 FR at 36325, col. 2, first paragraph (“(F)...”) is replaced with the following:

(F)(1) For an application that is subject to examination under the pre-AIA 35 U.S.C. 102 and 103: The accelerated examination support document must identify any cited references that may be disqualified as prior art under pre-AIA 35 U.S.C. 103(c) as amended by the Cooperative Research and Technology Enhancement (CREATE) Act (Pub. L. 108-453, 118 Stat. 3596 (2004)).

(F)(2) For an application that is subject to examination under AIA 35 U.S.C. 102 and 103: The accelerated examination support document must identify any cited references that may be disqualified as prior art under 35 U.S.C. 102(b)(2)(C).

The changes in Part III are as follows:

71 FR at 36325, col. 3, second paragraph (“If an...”) is replaced with the following:

If an Office action other than a notice of allowance is mailed, the Office action will set a shortened statutory period of two (2) months. Extensions of time under the provisions of 37 CFR 1.136(a) will be permitted, but will result in the application being taken out of

the program. Failure to timely file a reply will result in abandonment of the application. See Parts V and VI for more information on post-allowance and after-final procedures.

The changes in Part VI are as follows:

71 FR at 36326, col. 1-2, third paragraph (“After-Final and Appeal Procedures”) is replaced with the following:

After-Final and Appeal Procedures: The mailing of a final Office action or the filing of a notice of appeal, whichever is earlier, is the final disposition for purposes of the twelve-month goal for the program. Prior to the mailing of a final Office action, the USPTO will conduct a conference to review the rejections set forth in the final Office action (i.e., the type of conference conducted in an application on appeal when the applicant requests a pre-appeal brief conference). In order for the application to be expeditiously forwarded to the Patent Trial and Appeal Board (PTAB) for a decision, applicant must: (1) promptly file the notice of appeal, appeal brief, and appeal fees; and (2) not request a pre-appeal brief conference. A pre-appeal brief conference would not be of value in an application under a final Office action because the examiner will have already conducted such a conference prior to mailing the final Office action. During the appeal process, the application will be treated in accordance with the normal appeal procedures. The USPTO will continue to treat the application special under the accelerated examination program after the decision by the PTAB.

The changes in Part VIII are as follows:

71 FR at 36326, col. 3, ninth paragraph (“(G)...”) is replaced with the following:

(G) Electronic submissions of sequence listings in compliance with 37 CFR 1.821(c) or (e), large tables, or computer listings in compliance with 37 CFR 1.96, submitted via the USPTO's electronic filing system (EFS-Web) in ASCII text as part of an associated file (if applicable);

71 FR at 36326, col. 3, tenth paragraph (“(H)...”) is replaced with the following:

(H) Foreign priority claim under 35 U.S.C. 119(a)-(d) identified in the application data sheet (if applicable);

71 FR at 36326-27, col. 3, eleventh paragraph (“(I)...”) is replaced with the following:

(I) Domestic benefit claims under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in compliance with 37 CFR 1.78 (e.g., the specific reference to the prior application must be submitted in an application data sheet, and for any benefit claim to a non-English language provisional application, the application must include a statement that: (a) an English language translation, and (b) a statement that the translation is accurate, have been filed in the provisional application) (if applicable);

71 FR at 36327, col. 1, third paragraph (“(L)...”) is replaced with the following:

(L) No petition under 37 CFR 1.46(b)(2) to designate a person with sufficient proprietary interest as the applicant.

71 FR at 36327, col. 1, fifth paragraph (“Applicant should...”) is replaced with the following:

Applicant should also provide a suggested classification (i.e., group/subgroup of the Cooperative Patent Classification for utility applications or class/subclass of the U.S.

Patent Classification for design applications) for the application on the transmittal letter, petition, or an application data sheet as set forth in 37 CFR 1.76(b)(3) so that the application can be expeditiously processed.

71 FR at 36327, col. 1, sixth paragraph (“The petition...”) is replaced with the following:

The petition to make special will be dismissed if the application omits an item or includes a paper that causes the Office of Patent Application Processing (OPAP) to mail a notice during the formality review (e.g., a notice of incomplete application, notice to file missing parts, notice to file corrected application papers, notice of omitted items, or notice of informal application). The opportunity to perfect a petition (Part II) does not apply to applications that are not in condition for examination on filing.

71 FR at 36327, col. 1, seventh paragraph (“Reply Not...”) is replaced with the following:

Reply Not Fully Responsive: If a reply to a non-final Office action is not fully responsive, but a bona fide attempt to advance the application to final action, the examiner may provide two (2) months for applicant to supply the omission or a fully responsive reply. Extensions of time under the provisions of 37 CFR 1.136(a) are permitted, but will result in the application being taken out of the program. Failure to timely file the omission or a fully responsive reply will result in abandonment of the application.

If the reply is not a bona fide attempt, no additional time period will be given. The time period set forth in the previous Office action will continue to run.

Dated: August 10, 2016.

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
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